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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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10/525,233

10/11/2005

Robert Sellars

P-7712-US

7201

49443 7590 08/20/2008  
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EXAMINER

MAH, CHUCK Y

ART UNIT

PAPER NUMBER

3677

MAIL DATE

DELIVERY MODE

08/20/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

|                              |                                      |  |  |
|------------------------------|--------------------------------------|--|--|
| <b>Office Action Summary</b> | <b>Application No.</b><br>10/525,233 | <b>Applicant(s)</b><br>SELLARS, ROBERT |  |
|                              | <b>Examiner</b><br>Chuck Mah         | <b>Art Unit</b><br>3677                |  |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 May 2008.
- 2a) ☒ This action is **FINAL**.                      2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1,2 and 4-27 is/are pending in the application.
- 4a) Of the above claim(s) 16-21 and 23-25 is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☐ Claim(s) 1,2,4-15,22,26 and 27 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)          | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____                                      |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)          | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____  | 6) <input type="checkbox"/> Other: _____                          |

**DETAILED ACTION**

***Claim Rejections - 35 USC § 112***

1. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

2. Claim 27 is rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The original disclosure does not provide support for the limitations of "the recessed circular region has a diameter approximately half the size of the diameter of the cavity".

***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1, 2, 4, 5, 7-15, 22, 26 and 27 are rejected under 35 U.S.C. 103(a) as being unpatentable over Smith (1,356,566) in view of Oppenheimer (2,687,546) and Batyr (3,025,075).

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Smith '566 discloses the invention as claimed, including a housing 1, a main roller 5, bearing means 8, annular member 18, a centering means 11, and retaining means 12. Smith does not show a braking means (claim 1) and the circular recessed region (claims 26 and 27). Oppenheimer '546 teaches a braking means to provide directional control and braking action for the caster. '546 further teaches a recessed circular region (race way in housing 10 shown in figures 2 and 3, retaining support rollers 16.) It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the caster of '566 with the braking means of '546 to provide directional control and braking action for the caster. And it would have been obvious to one skilled in the art at the time the invention was made to modify the housing of '566 with a race way to retain the bearing in proper position. As to the diameter of the recessed region relative to the diameter of the cavity, it would have been an obvious matter of design choice to make the diameter of the recessed circular region half the size of the diameter of the cavity, or whatever relative sizes were desired, since such a modification would have involved a mere change in the proportions of components. A change in proportion is generally recognized as being within the level of ordinary skill in the art. *In re Reese*, 129 USPQ 402.

Further, Smith '566 does not show the support rollers protruding farther from the openings of the roller retainer towards the first end and the second end of the housing than does the annular member, as claimed in claims 1 and 5. Batyr '075 teaches a similar caster having an anti-friction thrust bearing ring (22) with the rollers protruding farther towards the ends of the housing than does the annular member. Because both

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Smith '566 and Batyr '075 teach an anti-friction thrust bearing to reduce friction, it would have been obvious to one skilled in the art at the time the invention was made to substitute one bearing for the other to achieve the predictable result of reduce friction between the housing and the ball caster. *KSR International Co. v. Teleflex Inc.*, 550 U.S. -, 82 USPQ 2d 1385 (2007).

As to claim 10, it would have been an obvious matter of design choice to make the retainer a "circlip" or of whatever form or shape was desired or expedient. A change in form or shape is generally recognized as being within the level of ordinary skill in the art, absent any showing of unexpected results. *In re Dailey et al.*, 149 USPQ 47.

5. Claim 6 is rejected under 35 U.S.C. 103(a) as being unpatentable over Smith '566, Oppenheimer '546 and Batyr '075 as applied to claims above, and further in view of Fierling (6,200,038).

Prior art '566, '546 and '075 do not show the openings of the bearing retainer having a diameter varying in the direction of thickness and having a minimum diameter that is less than the diameter of the roller. Fierling '038 teaches a bearing retainer 17 having an opening 22 with a diameter varying in the direction of thickness (figures 7 and 8, along axis Y) and having a minimum diameter (portion of 24) that is less than the diameter of the roller, so that the roller-opening contact is moved away from the interior edges of the opening to reduce wear of the bearing retainer (col. 4, lines 19-34). It would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the openings of the bearing retainer of '075 with the openings of '038, so that

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the roller-opening contact is moved from the edges, to reduce wear of the bearing retainer.

### ***Response to Arguments***

6. Applicant's arguments filed 5/15/2008 have been fully considered but they are not persuasive. Applicant's argument is mainly based on the newly amended portion of claim 1, regarding the specific structures of the openings and the support rollers of the annular member. However, the invention as claimed is deemed obvious features, as stated in the new-ground rejection in paragraphs 4 and 5 above.

### ***Conclusion***

**7. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

8. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Chuck Mah whose telephone number is (571)272-7059. The examiner can normally be reached on 5/4-9.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Judy Swann can be reached on (571)272-7075. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Chuck Mah/

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Primary Examiner, Art Unit 3677

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